REMARKS

Claims 1 and 3-13 will be pending upon entry of the present amendment. Claims 1 and 3-7 are being amended. Claims 8-13 are new. No new matter is being presented.

Rejections of Claims 1 and 3-7 Under 35 U.S.C. § 103(a)

Claims 1 and 5-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,529,714 to Nakamura *et al.* ("Nakamura") in view of U.S. Patent No. 5,531,365 to Donnelly ("Donnelly"). (Office Action dated March 18, 2008, pages 5-7.) Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Donnelly, further in view of U.S. Patent No. 3,870,184 to Fuchs *et al.* ("Fuchs"). (Office Action dated March 18, 2008, page 7.) Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Donnelly, further in view of U.S. Patent No. 5,260,146 to Savovic *et al.* ("Savovic"). (Office Action dated March 18, 2008, page 7.) Applicants respectfully submit that claims 1 and 3-7 are patentable for at least the reasons set forth below.

Differences Between the Cited References and the Claims Support Non-Obviousness

It is respectfully submitted that the differences between the cited references and the claims establish that the claims are non-obvious. Independent claim 1 is being amended to clarify that the portable electronic apparatus includes a battery compartment lid that covers at least partly a battery pack and a battery compartment, and the battery compartment lid is a lever element arranged to bend a material of lower hardness by way of a leverage effect. Independent claim 6 is being amended to clarify that the mobile telephone includes a battery compartment lid that covers at least partly a battery pack and a battery compartment, and the lid is a lever element structured to remove a bottle cap from a bottle by bending the bottle cap using a leverage effect. Independent claim 7 is being amended to clarify that the mobile telephone housing includes a battery compartment lid being a lever element that is integrally arranged in the wall of the synthetic material structure and arranged to bend material by way of leverage effect and is arranged to cover at least partly a battery pack.

The claims at issue include not only the listed features, but also recite particular arrangements (*e.g.*, structural interrelationship limitations) among the features that are not taught or suggested by the cited references. Neither Nakamura nor Donnelly makes any mention of, or even recognizes, such claimed relationships between a battery compartment lid and housing, namely that the battery compartment lid is both integrally arranged or embedded in a wall and a lever element that bends a bottle cap by way of a leverage effect. Indeed, the Examiner recognizes that Nakamura fails to disclose the claimed limitations and points to Donnelly. (*See, e.g.,* Office Action dated March 18, 2008, page 6, second full paragraph.) Donnelly merely discloses a belt clip 60 that is specifically designed to couple to an adapter 6, not a lid, of a personal communications device. (*See, e.g.,* claims 1 and 10; col. 5, lines 33-43.) The Examiner points to the Donnelly belt clip 60 as a leverage element. (Advisory Action, page 2.) However, the cited Donnelly belt clip 60 is not a battery compartment lid, much less a battery compartment lid that is integrally arranged or embedded in a wall of a housing and that also bends a bottle cap. Donnelly discloses that a multi-purpose tool 62 of the belt clip 60 is designed to be disassembled from the personal communications device 2 before use. (Col. 6, lines 11-14.) (emphasis added). Nakamura and Donnelly, alone or in combination, thus fail to disclose, teach, or suggest the structural relationship of a battery compartment lid being both integrally arranged or embedded in a wall of a housing and being a lever element that bends a bottle cap by way of a leverage effect. Applicants were the first to recognize the desirability of such a claimed arrangement.

One of Ordinary Skill in the Art would be Deterred from Modifying Nakamura with Donnelly as Proposed in the Office Action

It is respectfully submitted that the teachings of Nakamura and Donnelly would deter one of ordinary skill in the art from making the modifications proposed in the Office Action. A prior art reference must be considered in its entirety, *i.e.,* as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Nakamura's thin-walled construction, smooth exterior surfaces, and desired lid functionality would discourage one of ordinary skill in the art from the Office Action's proposed modification of Nakamura and Donnelly.

Radio communication equipment is known to be made as lightweight as possible. Lightweight plastics are often used to make housings and other components of such equipment. The Nakamura telephone has the thin-walled housing 2 and the thin-walled lid 3 consistent with minimizing the overall weight of the telephone. These components are not designed for applying leverage, let alone leverage large enough to bend bottle caps. Using the Nakamura lid 3 to somehow bend bottle caps could cause, for example, fracturing, bending, and/or breaking of the lid 3.

The Nakamura lid 3 is also designed to cooperate with the housing 2 to provide a smooth external gripping surface. Figure 2 of Nakamura shows the smooth external surfaces of the telephone 1 that provide a comfortable grip. Using the Nakamura lid 3 to bend a bottle cap could permanently deform the lid 3 resulting in unwanted outwardly protruding edges of the lid 3 that would destroy the smooth contour of the telephone 1.

Conventional battery lids and housings of telephones have locking features that cooperate to provide a secure fit between the lids and housings. However, these locking features are not configured to withstand the stresses experienced when bending bottle caps. By way of example, the Nakamura housing 2 has relatively small rails (labeled in Figure 1 of Nakamura reproduced below) for slidably engaging the lid 2. The rails could break if the Nakamura lid 3 is used as a bottle opener. The rails are for guiding the lid 3 upwardly and downwardly along the housing 2, not for withstanding stresses produced when bending bottle caps, much less withstanding those stresses without being damaged so as to allow opening and closing of a recess 2A. Broken rails could prevent proper operation of the lid 3. One of ordinary skill in the art would recognize the importance of being capable of repeatedly opening and closing the battery lid to replace or reposition a battery or battery pack.

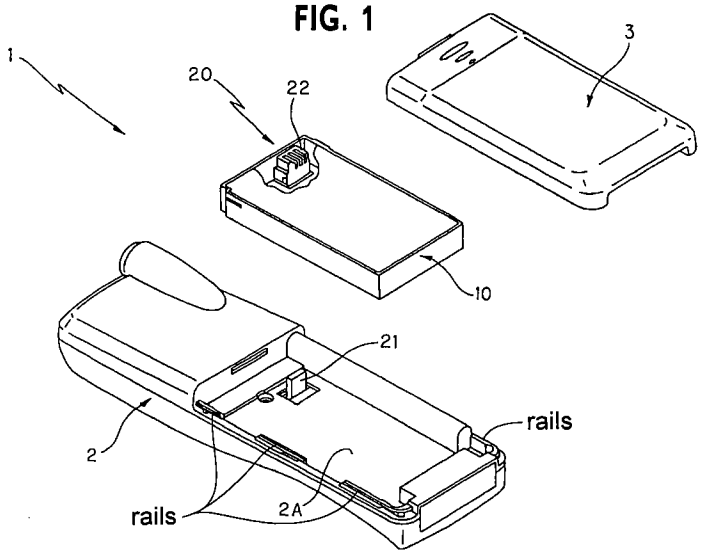

Figure 1 of Nakamura

Assuming *arguendo* that the Nakamura lid 3 could be modified to have the functionality of the Donnelly belt tool 60, the forces applied to the lid 3 to bend a bottle cap could result in significant stresses that could cause damage (*e.g.*, permanent deformation, fatigue damage, etc.) of mated portions of the lid 3 and housing 2, resulting in inoperability of the lid 3.

The lid 3 of Nakamura mates with the housing 2 to prevent external contaminants from entering the battery storing recess 2a shown in Figure 1. One of ordinary skill in the art would recognize that using the modified Nakamura lid 3 to bend bottle caps could cause deformation of the lid and separation between the edges of the lid 3 and the housing 2. Contaminants could thus enter the battery storing recess 2A. One of ordinary skill in the art would therefore recognize that using the Nakamura lid 3 in a manner proposed in the Office Action would tend to lead to contamination of the battery recess 2A resulting in impaired performance. These types of real world problems would deter one of ordinary skill in the art from making the proposed combination.

Consequently, Nakamura's thin-walled housing/lid construction, smooth exterior contour for gripping, and desired functionality would deter one of ordinary skill in the art from the Office Action's proposed modification of the Nakamura lid.

Office Action's Proposed Combination is Unsuitable for Donnelly's Intended Purpose of Protecting and Dissembling a Tool From the Personal Communication Device Before using the Donnelly Tool

The Office Action's proposed modification of the Nakamura lid 3 to incorporate the Donnelly tool 62 would render the Donnelly tool 62 unsatisfactory for the intended purpose of dissembling the component, which is used to remove a bottle cap from a personal communication device, before use, and thus, there is no suggestion or motivation to make the proposed modification. M.P.E.P. § 2143.01(V); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Donnelly recognizes problems (*e.g.*, user injury, damage to clothing, etc.) associated with the tool 62. (Col. 5, lines 44-52.) The tool 62 is protected by a sheath 64 and can be moved away from the telephone to open bottles. One of ordinary skill in the art would recognize the advantages of dissembling the tool 62 from the telephone to avoid problems (for example, user injury) when using the tool 62 as a bottle opener. The Office Action improperly disregards the problems recognized by Donnelly, and then proposes to somehow incorporate the features of Donnelly into the Nakamura lid 3, even though the Nakamura telephone does not have protective components, such as a sheath. Making the Donnelly tool 62 integral with the Nakamura lid 3 could cause the unwanted problems recognized by Donnelly supporting nonobviousness.

Office Action's Proposed Combination Involves Substantial Reconstruction and Changes the Basic Principle of Operation of the Nakamura Lid and Donnelly Belt Clip Tool

It is respectfully submitted that a *prima facie* case of obviousness also has not been presented because the suggested combination of cited references would involve substantial reconstruction and redesign of the components shown in Nakamura and Donnelly and would change the basic principle under which the cited features of Nakamura and Donnelly were designed to operate. *See* M.P.E.P. § 2143.01(VI); *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (CCPA 1959). The technical challenges of such substantial reconstruction and redesign would further deter one of ordinary skill in the art from the Office Action's proposed modification. The Nakamura lid 3 has numerous features (*e.g.*, a specific shape, wall thickness, structural features for coupling to the housing 2, etc.) for providing a lightweight telephone that can be comfortably gripped. The Office Action fails to set forth which features of Nakamura

would be eliminated/modified/replaced, fails to explain with any reasonable specificity how the cited references could be combined, and fails to provide a proper motivation to eliminate/modify/replace the features of Nakamura to allow the Nakamura lid 3 to somehow function as a bottle opener. The Office Action simply fails to appreciate the significant changes in weight, dimensions, and physical properties of the Nakamura lid 3 that would be needed to somehow make the Nakamura lid 3 function as a bottle opener.

Office Action Bases Rejection on Conclusory Statements

The Office Action summarily concludes that combining Nakamura and Donnelly would have been obvious without providing a clearly articulated reason for redesigning the Nakamura lid 3, so that the lid 3 is capable of bending a bottle cap. The Office Action dated March 18, 2008, on page 6, merely states that "it would have been obvious to one of ordinary skill at the time the invention was made to modify Nakamura to incorporate the lever element being arranged to be a material of lower hardness . . . The motivation for the modification is to do so in order to provide a lever element incorporating the bottle cap opener such that the user can enjoy the benefit of using the lever element for multipurpose use." This ignores the fact that the belt clip 60 of Donnelly is already designed to couple to a telephone. That is, Donnelly already provides the bottle cap opening functionality without requiring reconstruction of a lid. The Examiner fails to articulate a specific reason to modify the Nakamura lid 3 with the teachings of Donnelly to somehow enable the Nakamura lid 3 to be not only a lever element, but a lever element capable of bending a bottle cap. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited in KSR Int'l Co. v. Teleflex Inc., et al.*, 127 S. Ct. 1727, 1740-1741 (2007). The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the *desirability* of the combination. MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)) (emphasis added); *see also KSR Int'l Co.*at 1740-1741 (2007) (Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place; and the background knowledge possessed

by a person having ordinary skill in the art, all in order to determine *whether there was an apparent reason to combine* the known elements in the fashion claimed by the patent at issue) (emphasis added). Moreover, the Office Action failed to detail how one of ordinary skill in the art would modify the Nakamura lid 3 to operate as a lever element as claimed, as detailed above. Consequently, the Office Action's rejections are improperly based on conclusory statements.

Dependent Claims 3-5

Dependent claims 3-5 are allowable as depending from allowable base claim 1, as well as for novel and nonobvious combinations of elements recited therein.

New Claims

Claims 8-13 have been added. These claims are fully supported by the application as filed. No new matter has been added. The cited references fail to disclose features of claims 8-13. For example, as noted above, Nakamura and Donnelly, alone or in combination, fail to disclose a lever element integrally arranged in the wall of the synthetic material structure made of metal or ceramic.

Conclusion

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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